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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/686,641

Applicant(s)

MITTAL ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it should be a single paragraph. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not provide a concrete, useful and tangible result. The claims merely set forth means for and methods for collecting auction data and analyzing the data to estimate demand and calculate coupon parameters. Without generation of or issuance of the resulting coupons, the claims fall short of the required concrete, useful and tangible result.

### ***Claim Objections***

1. Claim 10 is objected to because of the following informalities:
  - Claim 10, applicant should apparently delete the “the” before “means.”
  - Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 3, 5, 19, 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 2, 5 are of unclear claim scope for the “such as” language.
- Claim 19, there is no clear antecedent basis for the electronic coupon issuing system.
- Claim 61, there is no clear antecedent basis for the curve.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-18, 20-37, 39-56, 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeny, Jr (US6513016) in view of Godin et al (US5890138).

Regarding claim 1, 4-6, 18, 58-61, Freeny, Jr teaches a computerized system that monitors sales, demand and inventory supply and dynamically adjusts pricing. The system enables advertising/promotional pricing using coupons that can be printed for customers and redeemed. The coupon system generates coupons that are dynamically

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priced as determined by the system [abstract, 4:4-11, 6:32-37, 7:35-37, 11:16-27]. The coupon system is taken to be electronic as the coupon data is stored on the computer and can be electronically changed. Further, the coupons include UPC codes which are electronically scanned upon redemption. While Freeny, Jr teaches several data inputs to the price determination system, he does not teach the use of auction data. Godin et al teaches an online computer auction system which is used to sell goods. Godin et al teaches that a feature of the auctions is the ability to track the price/demand nature of the product. This provides valuable information to the manufacturer. Instead of detailed testing, businesses can use auction data to determine price and demand information for specified products and a price demand curve can be created [7:60-8:5]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such auction data and an input to the system of Freeny, Jr in order to create pricing based upon such price demand data. Regarding claim 18, providing the suggested auction-data input to the computerized pricing system functionality in order to output pricing decision and actions is taken to provide the user with "configured" data sources and auction parameters. Regarding claim 58, the system is taken to inherently "learn" about online markets by mining information from current and past operations of similar online markets. Regarding claim 59, Freeny, Jr teaches that the system monitors inventory levels and can adjust pricing accordingly. This is taken to provide optimal inventory management. Regarding claims 60, the proposed combination provides an online electronic coupon generation system. Regarding claim 61, it would have been obvious to one of ordinary skill at the time of the invention to have sold the marketing research

to other firms so that they may use the same techniques to price, promote and sell their products.

Regarding claim 2, 3, 17, it would have been obvious to one of ordinary skill at the time of the invention to have electronically captured valuable auction data input for any well known auction types (such as Dutch auction, reverse auction, etc), so as to base pricing on a wide range of data in an automated manner.

Regarding claim 7, 9, 14-16, the demand curves taught by Freeny, Jr inherently provide price elasticity based on the results of the auctions for a plurality of products and a plurality of quantities. Official Notice is taken that it is well known to estimate demand curves in such a manner and it would have been obvious to one of ordinary skill at the time of the invention to have done so in order to model the price/demand data and determine an optimized promotion pricing. Regarding claim 16, a price demand curve inherently associates quantities demanded and price, for a collection of individual buyers.

Regarding claim 8, promotion coupon and advertising campaigns typically include such claimed parameters and it would have been obvious to one of ordinary skill at the time of the invention to have provided them in order to provide an effective promotion.

Regarding claim 10, 11, 13, Official Notice is taken that providing promotion pricing to encourage switching from a competitors product, and cross-selling and up-selling are well known marketing techniques; such would have been obvious to have employed in order to accomplish sales.

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Regarding claim 12, plural auctions for different products can inherently define different segments based on the product type. A marketer could define segments in any imaginable way for a plurality of products.

6. Claims 21-38 and 39-57 are each rejected following the same reasoning as per claims 1-19 above.

7. Claims 19, 38, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeny, Jr in view of Godin et al and Schulze, Jr (US6497360). Schulze, Jr teaches an electronic coupon promotional system where the coupon output is used as an input to the coupon system in order to provide a feedback loop to improve the system [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have fed back the results of the coupon system of Freeny, Jr/Godin et al as a closed loop system in order to improve results and provide a system that "learns."

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Auctiva Names Mark A. Schwartz (Business Wire 8/23/2000) teaches that auction marketplaces provide a means for gathering useful data on demand and optimal pricing strategies.


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- Halbert et al teaches an auction system whereby the results histories are analyzed to provide demand and pricing relationships.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc